REMARKS

This Amendment is filed in response to the Office Action dated August 29, 2005. All objections and rejections are respectfully traversed.

Claims 1-34 are in the present application. Claims 1-21, 23, 25-28 and 30-34 have been amended to better claim the invention.

In paragraphs 4 and 5 of the Office Action, the Examiner rejected claims 8 and 33-34 under 35 U.S.C. §101 as non-statutory subject matter.

The present invention, as set out in representative claim 8, comprises in part:

> 8. Electromagnetic signals propagating over a computer network the electromagnetic signals carrying instructions for execution on a processor for the practice of the method of:

Applicant respectfully urges that the novel method steps are tangibly embodied in the electromagnetic signals propagating on the computer network. Further, Applicant respectfully urges that the embodiment of electromagnetic signals for transfer of instructions for execution on a processor for the practice of a method between computers fully satisfies all requirements of 35 U.S.C. § 101, and all requirements set out in the MPEP.

That is, Applicant respectfully urges that embodiment of the instructions in electromagnetic signals meets all of the requirements of 35 U.S.C. § 101, especially as clarified by MPEP 2106 IV, B, 1(c) at page 2106 of MPEP 8th Edition Incorporating Revision No. 2. (hereinafter "MPEP 2106 IV, B, 1(c)"). Further, MPEP 2106 IV, B, 1(c) states, at page 2106:

"However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature, see *O'Reilly* 56 U.S. at 114-19; *In re Breslow*, 616 F. 2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980)."

In the case *In re Breslow* claims were permitted by the Court (CCPA) to chemical species which are transient in nature, and cannot be separated out of the mixture in which they are created. The MPEP cites this patentability of transitory phenomena in chemical reactions in support of the statement by the MPEP, "However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature".

The important point for patentability is the practical application of electromagnetic energy. And a practical application of electromagnetic energy is transmission of a computer program over a computer network, where the computer program is for the practice of a novel method. This practical application of electromagnetic energy is patentable subject matter, as explained by MPEP 2106 IV, B, 1(c).

Applicant respectfully urges that imbedding instructions for execution on a processor in an electromagnetic signal propagating on a computer network meets the practical

application requirements of 35 U.S.C. § 101 and of MPEP 2106 IV, B, 1(c), and that claims 8, 33 and 34 therefore claim statutory subject matter.

In paragraphs 6 and 7 of the Office Action, the Examiner rejected claims 1-5, 7-12, 14, 16-23, 25-30 and 32-33 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,085,201 (hereinafter "Tso"). Applicant respectfully traverses this rejection.

The system described by Tso is directed to a different subject than that claimed by the present invention. Tso is directed to a system that identifies a template to be utilized to enable the easy response to an electronic message. The Tso system is designed to locate and retrieve a pre-defined template that has the highest weight value after the Tso template engine completes processing of a user defined text string.

In contrast, the claimed invention locates substantive information that is associated with information located in the document, e.g., an address that is associated with a name already entered into a document.

Additionally, in Tso, the user must define the text string that is to be utilized for further processing. Specifically, in Tso, the user must define a text string by clicking on it or by locating the cursor within a desired sentence and pressing an "ENTER" key. Tso, column 4, lines 31-42. The sentence thus identified by the user is then utilized as the text string to be processed by assigning a total value to the sentence based on values for each word in the sentence, for each available template, and opening the template with the highest score for the sentence defined by the user. Tso, column 5, lines 1-22.

Tso's requirement that the user define the text string to be processed is one difference between the Tso system and the claimed invention. Illustrative claim 1 includes, in relevant part, the claim element of

> "*programmatically* analyzing the first information to define search information to be utilized in a second application program," (emphasis added)

We have modified the term "analyzing" by prefixing it with the term "programmatically" to more strongly emphasize that the analysis referred to is done by the software program, not the user. We believe that those skilled in the art would understand this to be the meaning of the term "analyzing" even without the newly-added modifier, but have added the modifier to emphasize this point. Thus, Applicant's claimed invention automatically identifies the information to be utilized in the second application program. This is in distinction to Tso, which requires that the user define the information to be utilized by, e.g., clicking on the sentence.

Furthermore, the claimed invention uses search information (i.e., the text to be processed) in a second application program to find second information associated with the search information, whereas Tso teaches a system in which the text to be processed is decomposed into words and weight values associated with each word is added to a running total of weight values for each template in order to designate which template is the most appropriate for the text string defined by the user (i.e., the text to be processed). Tso, column 7, lines 7-17.

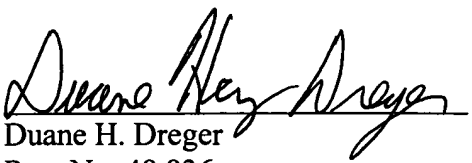
Furthermore, with regard to claim 1, Tso does not insert any information into the document from which the original information is located. Instead, Tso inserts text (after template processing) into a new message that is being composed. Tso, column 6, line 66 – column 7, line 2. This is in contrast to Applicant's claimed invention which inserts "into the document a second information from the second application program." Thus, Tso does not anticipate claim 1 as it does not insert any information into the document, but instead opens a *second* document.

In paragraph 8, the Examiner rejected claims 6, 13, 15, 24 and 31 under 35 U.S.C. §103(a) over Tso in view of U.S. Patent No. 5,859,636 (hereinafter "Pandit"). Applicant respectfully traverses this rejection. Each of these claims is a dependent claim. Applicant respectfully states that each of these claims is allowable at least because it depends from an allowable base claim.

The claims are believed to be in a condition for allowance. Favorable action is respectfully requested.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,



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